



Attorney Docket Number EFIM0215

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Margaret Motamed  
Serial No. : 09/661,489  
Filed : 14 September 2000  
For : METHOD AND SYSTEM FOR MERGING SCAN  
FILES INTO A COLOR WORKFLOW  
Group Art Unit : 2626  
Examiner : MARK E. WALLERSON

PETITION UNDER 37 C.F.R. § 1.313(c)(2)  
TO WITHDRAW FROM ISSUE

Mail Stop: 313(c)  
Commissioner for Patents  
PO BOX 1450  
Alexandria, VA 22313-1450

Sir:


On July 18, 2005, the undersigned attorney for applicant received in the U.S. mail a Communication from the European Patent Office ("Communication") (copy attached hereto as Exhibit A) from a counterpart European case. The Communication cites three references ("References") that were not cited in this case.

On July 18, 2005, prior to reviewing the Communication, the undersigned attorney paid the issue fee for this case, which was due by August 6, 2005. Applicant respectfully requests that this case be withdrawn from issue so that the Examiner may review the References, which the Communication alleges anticipate or render obvious several of the claims.

In particular, applicant has prepared a proposed request for continued examination ("RCE") (enclosed herewith) that includes an information disclosure

statement, a PTO Form-1449 and copies of the references cited in the Communication. Applicant respectfully requests that this case be withdrawn from issue so that the enclosed RCE may be considered. Applicant submits herewith the fee set forth in 37 C.F.R. § 1.17(h).

Respectfully submitted,

  
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Generaldirektion 2

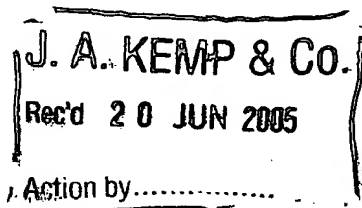
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Application No. 01 966 472.1 - 2202	Ref. N.88127 JGL	Date 14.06.2005
Applicant Electronics for Imaging, Inc.		

## Communication pursuant to Article 96(2) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

**of 4 months**

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

**Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).**



Moorhouse, D  
Primary Examiner  
for the Examining Division

Enclosure(s): 10 page/s reasons (Form 2906)  
Copies of US-B1-6 549 302, JP-A-11 196 257, EP-A-0 993 178,  
US-A-6 094 276 and US-A-5 911 044

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The examination is being carried out on the **following application documents**:

## Description, Pages

1-10 as published

## Claims, Numbers

1-52 as published

## Drawings, Sheets

1/12-12/12 as published

1. The following documents are cited:

D1 : US-B1-6 549 302 & JP-A-11 196 257

D2 : EP-A-0 993 178

D3 : US-A-6 094 276

D4 : US-A-5 911 044

The above documents are cited by the examiner (see the Guidelines, C-VI, 8.7).  
Copies of the documents are annexed to the communication.

It is to be noted that the US version of D1 was published after the priority date of the present application. The JP version was published 21/7/1999, and is thus prior art under Article 54 (2) EPC. The two publications derive from the same priority application, and have identical drawings, and are thus assumed to be identical in their



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content. The US document is thus used as a translation of the JP document, and any references to passages of document D1 should be understood as relating to the US version.

2. Claims 2, 4, 7, 8, 14, 17, 18, 30 to 32, 34, 35, 41, 43 and 47 to 49 lack clarity and / or support in the description, and are therefore not allowable according to Article 84 EPC. The objections are explained in detail below.

### Claim 2

This claim refers to a "document file and a scanned image file". While the latter type of file is mentioned in the description, a "document file" lacks support. Instead, the description mentions "text". Furthermore, the meaning of the wording "document file" is unclear, since a document may consist of text and images.

### Claims 4, 31

The wording "a control panel on said scanning device" lacks support in the description.

### Claims 7, 8, 34, 35

A "mass storage device" lacks support in the description.

### Claims 14, 41

The step of / means for "specifying one of an image scan and a document scan" lacks support in the description, for reasons set out above with respect to claim 2.

### Claims 17, 43

These claims imply that a possible modification is "specifying source type". This does not appear to be a modification which it is possible to make to an already scanned file. Instead, it would appear that specifying a "source type" is carried out before scanning.

### Claims 18 and 32

It is not clear, where the "second software module" is.

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## Claim 30

This claim is objected to for reasons set out above with respect to claim 2. Further, it is not clear from the wording "is convertible", whether means are actually provided for doing such a conversion.



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Claims 47 to 49

These claims suggest that the system "comprises a template". It is not clear how this can be the case, since a "template" is a set of predefined instructions, and not an apparatus feature.

3. The above lacks of clarity and support notwithstanding, as full an examination as is possible in the circumstances has been carried out with respect to the requirements set out in Articles 52 to 56 EPC.
4. The subject-matter of claims 1, 7, 8 and 51 lacks novelty. Claims 1, 7, 8 and 51 are therefore not allowable according to Articles 52 (1) and 54 EPC.

Document D1 discloses:

A method of merging document files into a printing workflow, comprising the steps of:  
 providing a plurality of document files (document 1 to document 3), each of said files comprising one or more pages, all (i.e. "at least one") of said files being scan files

displaying an image of each page of each of said document files (see Figures 5 to 7);

selecting at least one page from each of at least two of said document files; and  
 combining said selected pages in a desired order, wherein said scanned files are merged with said document files on a page-by-page basis so that said combined pages comprise a new document file (see Figures 7 and 16 and column 14, line 41 to column 15, line 21).

Thus, the subject-matter of claim 1 is known from document D1.

The subject-matter of claims 7 and 8 is known from document D1 (see storage 16 in Figure 1).



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Document D2 discloses:

A system for copying documents, said system being functionally equivalent to a copying machine, comprising:

- a print server (implied by column 3, lines 17 to 23);
- a print engine connected to said print server (idem);
- a client workstation in communication with said print server (see Figure 3);
- a scanner attached to said client workstation (34); and
- a software module, said software module permitting said print engine and said scanner to function as a copying machine (see the printer icon in the GUI of Figure 11).

Thus, the subject-matter of claim 51 is known from document D2.

5. The subject-matter of claims 2 to 6, 9 to 50 and 52 lacks an inventive step. These claims are therefore not allowable according to Articles 52 (1) and 56 EPC.

The additional features of claim 2 relate to well known types of scanned image and well known document formats. Their uses in the system disclosed in document D1 are the result of routine design procedure and thus of no inventive significance.

The provision of a scanning device (1000) connected to a print server (200) is known from document D3. The disclosure of document D3 is quite old, and in the meantime, colour printers have become more common. Thus, the additional features of claim 3 are rendered obvious by the disclosure of document D3.

The additional features of claim 4 are either disclosed in document D3 (see server display / GUI driver 240 and 242), or are obvious alternatives thereto, and are thus of no inventive significance.

The incorporation of a print server into a copier is a well known measure in the art. Thus, the additional features of claim 5 are of no inventive significance.

The additional features of claim 6 are rendered obvious by the disclosure of





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document D4 (see Figure 10 and column 15, lines 41 to 55) and by the disclosure of document D2 (see Figure 11 and paragraphs [0131] to [0133]).

The additional features of claim 9 are rendered obvious by the disclosure of document D4 (see Figure 14B, step 762; Figure 15).

The additional feature of claim 10 is rendered obvious by the disclosure of document D1 (see column 3, lines 40 and 41).

The additional features of claim 11 are rendered obvious by the disclosure of document D3 (copier platen) and by the disclosure of document D4 (dedicated scanner).

The additional feature of claim 12 is rendered obvious for reasons set out above with respect to claim 3.

The additional feature of claim 13 is rendered obvious by the disclosure of document D4 (see Figure 1) and document D2 (see Figure 3).

The additional features of claims 14 and 15 relate to features of scanning operations, which are either disclosed in the documents D1 to D4, or are obvious parameters for which setting should be facilitated.

The additional feature of claim 16 is rendered obvious for reasons set out above with respect to claim 9.

The additional features of claim 17 are objected to for reasons similar to those set out above with respect to claims 14 and 15.

The additional features of claims 18 to 20 are rendered obvious by the disclosure of document D1 (see Figures 5 to 7 and column 7, lines 14 to 18).

The additional features of claims 21 to 25 relate to a well known way of making repetitive actions easier to carry out in a computer environment. The solution has



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been variously known as a subroutine, macro, template or, more recently, a script and is so well known as to be of no inventive significance.

The additional features of claim 26 are rendered obvious for reasons set out above with respect to claim 2.

Document D2 discloses :

A system for merging scan files into a printing workflow, comprising:

- a print server (implied by column 3, lines 17 to 23);
- a client workstation in communication with said print server (see Figure 3);
- a scanning device (34), said scanning device connected to one of said workstation and said print server (see Figure 1 - connection to the workstation);
- means for initiating and customizing scans, said scans performed by said scanning device (see column 15, line 41 to column 16, line 30).

Moreover, as set out above, document D1 discloses the page-by-page merging of scanned documents. Since both documents relate to scanning of documents, it would be obvious to combine their documents, thus arriving at the subject-matter of independent claim 27.

The additional feature of claim 28 is normal in the computer programming field, and is thus of no inventive significance.

The additional features of claim 29 are rendered obvious by the disclosure of document D1, Figures 7 and 16 and associated text passages.

The additional features of claim 30 are rendered obvious for reasons set out above with respect to claim 2.

The additional features of claim 31 are rendered obvious for reasons set out above with respect to claim 4.

The additional features of claim 32 are rendered obvious for reasons set out above

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with respect to claim 6.

The additional features of claim 33 are rendered obvious for reasons set out above with respect to claim 9.

The additional features of claims 34 and 35 are rendered obvious for reasons set out above with respect to claims 7 and 8.



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The additional features of claims 36 to 40 are rendered obvious for reasons set out above with respect to claims 9 to 13.

The additional features of claims 41 and 42 are rendered obvious for reasons set out above with respect to claims 14 and 15.

The additional features of claims 43 to 49 are rendered obvious for reasons set out above with respect to claims 17 to 23.

The additional features of claim 50 are rendered obvious for reasons set out above with respect to claim 26.

The additional features of claim 52 relate to an obvious alternative display to that shown in Figure 11 of document D1.

6. It is not at present apparent which part of the application could serve as a basis for a new, allowable claim. Should the applicant nevertheless regard some particular matter as patentable an independent claim including such matter should be filed taking account of Rule 29 (1) EPC, together with dependent claims as appropriate. The applicant should also indicate in the letter of reply the difference between the subject-matter of the new claim and the state of the art and the significance thereof.
7. If such a claim or claims is / are to be filed, then the following points should also be noted :-

The ultimately adopted independent claims should be divided in the proper two-part form based on document D1. (Rule 29 (1) (a) and (b) EPC). This requires inclusion in the preamble, of at least those features known in combination from document D1 as set out above.

The opening pages of the description should be augmented to provide an acknowledgement of the background art (Rule 27 (1) (b) EPC) as disclosed in documents D1 to D4.



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The consistory clause forming the disclosure of the invention(s) as claimed, should be brought into the agreement with the claim(s) of broadest scope (Rule 27 (1) (c) EPC).

Bracketed reference numerals should be included throughout the claims as this would improve their intelligibility (Rule 29 (7) EPC).

The "spirit and scope" clauses must be deleted from pages 5 and 10. (Article 84 and Rule 34 (1) (c) EPC).

Care should be taken to avoid giving rise to further objections by the inadvertent addition of subject-matter (Article 123 (2) EPC), and to ensure that the claims relate to a single invention (Article 82 EPC).

The Applicant is requested to file amendments by way of replacement pages. The Applicant should also take account of the requirements of Rule 36 (1) EPC. In particular, fair copies of the amendments should be filed in triplicate. Handwritten amendments should be avoided according to Rules 36 (1) and 35 (10) EPC, in particular with a view to avoiding mistakes in printing any patent which might result from the present Application.